REMARKS

I. Introduction

Claims 1-17 continue to be pending in the application. In the Office Action: (1) claims 1-5 and 11-13 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2001/0054087 to Flom et al. (hereinafter "Flom"); and claims 6-10 and 14-17 were rejected under 35 U.S.C. §103(a) as being obvious over Flom in view of U.S. Publication No. 2002/0052824 to Mahanti et al. (hereinafter "Mahanti"). The rejections were made final.

Applicant respectfully traverses the rejections based on at least the reasons discussed below. In particular, claims 1-17 are in condition for allowance because the Examiner has not established a *prima facie* case of anticipation or obviousness for every limitation recited in the claims. Further, the cited prior art fails to teach each and every claim limitation. There is also no motivation to modify or combine the cited references as asserted by the Examiner.

II. Rejection of claims 1-5 and 11-13 under 35 U.S.C. 102(e) over Flom

In the Office Action, the Examiner rejected Claims 1-5 and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Flom. However, the Office Action has failed to establish a *prima facie* case of anticipation because Flom fails to teach every limitation recited in the claims. It is a fundamental principle of patent law, that a claim is not anticipated unless each and every element of the claimed invention is present in the cited reference. Flom fails to teach several claim limitations. Accordingly, for at least the reasons presented below, Applicant respectfully requests that the rejections under § 102(e) be withdrawn.

A. Flom does not disclose dynamically composing user-specific information as recited in claims 1 and 11.

In regards to claim 1, the Examiner asserts on page 5 of the Office Action that paragraphs 7-9 and 67 of Flom disclose dynamically composing user-specific information as personalized, user-specific output based on data in the object database and the user profile. In relation to claim 11, the Examiner asserts on page 8 of the Office Action that paragraphs 58-59 of Flom disclose the same functionalities. However, Flom relies on static caching and fails to teach dynamically composing user-specific information as recited in claims 1 and 11. Claim 1 recites, in part:

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a dynamic information composer coupled to the object database and
the user profile database; and
wherein the dynamic information composer *dynamically
composes user-specific information* as a personalized, user-specific
output *based on data in the object database and the user profile* while
simultaneously reducing network traffic.

(See Claim 1, emphasis added.) Thus, claim 1 is directed to dynamically composing user-
specific information based on data in the object database and the user profile. In other words,
the claimed mobile cache can compose personalized data stored by the object database based
on a user profile. Accordingly, cached data can be personalized for multiple users without
having to download new data from an origin server for a different user profile.

In contrast, Flom discloses a static caching system that does not personalize cached
data at a mobile cache. Flom teaches that relevant content packages are created at a content
manufacturing system (Fig. 9; paragraphs 7, 9, 31, 35, 44, 66, 67, 69), which manufacturing
system the Examiner asserts is an origin server (Office Action, page 5). In Flom's system, if
a user makes a request and the requested content is not available at a portable cache, the
portable cache's static data must be updated by newly requested and downloaded data created
by the content manufacturing system. Thus, Flom's teachings appear to be limited to creating
content packages only at a manufacturing source. In other words, Flom teaches a static
caching system lacking dynamic caching functionality.

As Applicant argued on pages 7-8 of the Amendment dated October 10, 2003
(hereinafter the "October 10 Amendment), Flom's teachings are limited to static caching
systems as described in the Background of the Invention of the present application:

"The information from the cache reaches the user faster and also relieves the
network from the burden of the additional traffic that would have occurred if
the Web page information had to be re-transmitted to the wireless device.
Currently, known-caching schemes in wireless applications, however, can deal
only with static data and cannot generate any information according to user-
specified parameters" Page 1, lines 19-23.

Thus, Flom exemplifies the state of the art discussed in the Background. Flom discloses the
formation of content packages that may be stored on electronic computer media such as a
storage system 14 (paragraph 53). Then, upon a user-request, the content distribution system
16 distributes the *pre-defined* content packages to portable web sites 18 for use by community

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users of portable electronic devices 94 (paragraph 55). However, if the static content packages do not contain requested information, the content distribution system 16 cannot manipulate the content packages to fit user requests. Instead, the content packages are updated with content packages created and sent over the Internet by the content manufacturing system 90. Thus, Flom's teachings of caching functionalities appear limited to distributed pre-defined content packages.

On page 3 of the Office Action, the Examiner responded to Applicant's argument that Flom "does not teach the dynamic nature of the invention" (October 10 Amendment, page 10). The Examiner points out that "Flom teaches preparing relevant content packages for users when requested relevant content packages are not present on server 92 (cache 92A), and forwarding them automatically to requesting user." As mentioned above, the content packages of Flom are prepared only at the content manufacturing system 90. Accordingly, the cited teaching of Flom does not relate the dynamic features recited in claims 1 and 11.

Further, Flom contains no disclosure of using its personal information object 10C to manipulate its information objects 10A or 10B. Flom does not teach any dynamic composition performed by the server 92 (cache 92A). Accordingly, Flom teaches a static caching system that is limited to distributing relevant *pre-defined* content packages. Therefore, claims 1, 11, and their dependent claims (claims 2-10 and 12-17) are in condition for allowance because Flom does not disclose "dynamically compos[ing] user-specific information" as recited in independent claims 1 and 11.

B.   Flom does not disclose a mobile cache including a user profile database and an object database as recited in claim 1.

On page 5 of the Office Action, the Examiner asserts that Flom discloses a mobile cache (Fig. 9, 92A), a user profile database (Fig. 1, source object 10), and an object database (paragraphs 6-9, 489-53, and 57-62). However, the support cited by the Examiner does not disclose a mobile cache *including* a user profile database and an object database as recited in claim 1. As shown in Fig. 1 of Flom, the source objects 10 are used by the content manufacturing system 90 to form content packages for distribution by the content distribution system 16 (paragraphs 53-55). The source objects 10 taught by Flom are not a user profile *database*. Moreover, Flom does not teach a mobile cache including both an object database and a user profile database. Flom's failure to teach dynamic caching features further

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evidences Flom's lack of a mobile cache including both an object database and a user profile database. Therefore, claim 1 and its dependent claims (claims 2-10) are in condition for allowance.

C.   Flom does not disclose a user profile generator as recited in claim 2.

On page 6 of the Office Action, the Examiner asserts that paragraphs 9-13 and 58-64 of Flom disclose a user profile generator coupled with the user profile database to generate a new user profile. However, the indicated paragraphs do not recite a profile generator. Instead, they teach away from the claimed invention. As Applicant argued on page 8 of the October 10 Amendment, Flom teaches the concept of creating a content package including personal information (see paragraph 12), but discloses nothing about how a user profile affects how the content packages are created let alone the use of a profile generator to create a new user profile. Paragraph 13 of Flom discloses the providing of information such as the location of a user of the portable device. However, this information is provided directly from the wireless device 94 (e.g., "manual entry"), and not from a user profile associated with a separate mobile cache separated from the device by a wireless network.

On page 2 of the Office Action, the Examiner disagreed with the Applicant's arguments presented on page 8 of the October 10 Amendment. The Examiner asserts that Flom teaches generating of customized content packages that include personal information. However, this teaching of Flom does not disclose the limitations of claim 2. Specifically, Flom's generation of content packages at the content manufacturing system 90 does not teach Applicant's user profile generator coupled with the user profile database to generate a new user profile. As discussed above, Flom does not teach a user profile database. Claim 2 is in condition for allowance at least because there is no disclosure of a profile generator as recited the claim.

D.   Flom does not disclose a change trigger as recited in claim 5.

On pages 2 and 7 of the Office Action, the Examiner asserts that paragraphs 31, 43-44, and 53-39 of Flom teach the change trigger as recited in claim 5. However, there is no teaching in Flom of "the change trigger monitor[ing] changes in the object database and trigger[ing] output delivery when a number of information changes in the object database reaches a predetermined threshold" (claim 5). The closest Flom comes to any such teaching

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is automatically notifying a user of a new or newly reviewed restaurant in a geographic area that matches criteria input by the user (paragraph 59). However, apprising a user of a new restaurant does not teach the claim limitation of monitoring when a *number* of information changes in the object database reaches a predetermined threshold. Flom does not disclose monitoring a number of information changes or when that number reaches a predetermined threshold. Therefore, claim 5 is in condition for allowance.

Claim 13 is also in condition for allowance for the same reasons. Specifically, claim 13 recites the steps of monitoring a number of information changes in the object database and triggering a delivery once the number of information changes reaches a predetermined threshold.

Moreover, Flom does not teach a change trigger that is included as part of a mobile cache. In contrast, all changes to the content packages taught by Flom occur at the content manufacturing system 90, which the Examiner asserts is equivalent to an origin server (Office Action, page 5). Accordingly, the notification of a new restaurant appears to be generated at the content manufacturing system 90 rather than at a mobile cache. For these reasons, claim 5 is in condition for allowance.

III. Rejection of claims 6-10 and 14-17 under 35 U.S.C. 103(a) as being obvious over Flom in view of Mahanti.

In the Office Action, the Examiner rejected claims 6-10 and 14-17 under 35 U.S.C. § 103(a) as being obvious over Flom in view of Mahanti. The arguments made above in connection with the Flom are equally applicable here. Accordingly, claims 6-10 and 14-17 are in condition for allowance as depending from independent claims 1 and 11. The Office Action has also failed to establish a *prima facie* case of obviousness because the cited references fail to teach every limitation recited in the claims. Moreover, there is no motivation to combine or modify the references to read on Applicant's claims. Accordingly, for at least the reasons presented below, Applicant respectfully requests that the rejections under § 103(a) be withdrawn.

A. There is no motivation to combine or modify the cited references to read on claims 6-10 and 14-17.

On page 9 of the Office Action, the Examiner admits that Flom does not disclose converting an image format and caching the converted image. On page 10 of the Office

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Action, the Examiner asserts that given Mahanti's teaching of image format conversion, a person of ordinary skill in the art would have recognized the desirability of modifying Flom with the system of Mahanti. However, there would have been no motivation to modify Flom based on Mahanti because Mahanti is unrelated to wireless applications. The system of Mahanti is directed to automated negotiation processing and does not appear to include any teaching related to caching associated with a wireless device. Therefore, one of ordinary skill in the art would not have been motivated to modify Flom as suggested by the Examiner. Accordingly, claims 6-10 and 14-17 are in condition for allowance because the Examiner has not established a *prima facie* case of obviousness against claims 6-10 and 14-17.

B. The cited references do not teach extracting data segments of the selected data based on the output preference data as recited in claims 7, 9, and 16.

On page 10 of the Office Action, the Examiner asserts that paragraphs 41-43 of Mahanti disclose extracting data segments. The Examiner also asserts that Flom discloses "based on the output preference data" according to the Office Action's rejection of claim 1. However, the Examiner's rejection of claim 1 (Office Action, page 10) does not cite any teaching in Flom of extracting data segments based on output preference data. The Examiner's discussions of output preference data in the rejections of claim 1 are related to dynamically composing user-specific output data and do not mention any functionality of extracting data segments. Further, Flom contains no teaching of extracting data segments. Thus, Flom does not teach extracting data segments of the selected data based on the output preference data.

Similarly, Mahanti does not teach extracting data segments based on the output preference data. In particular, there is no teaching of output preference data in paragraphs 41-43 that were cited by the Examiner. Thus, although the Examiner points out of pages 3-4 of the Office Action that the rejections of claims 7, 9, and 16 are based on combinations of references, the cited references fail to teach the claim limitations as a whole. Even if one of ordinary skill would have been motivated to combine the references, the combined references do not teach extracting data segments based on the output preference data. Therefore, claims 7, 9, and 16 are in condition for allowance because the Examiner has not established a *prima facie* case of obviousness.

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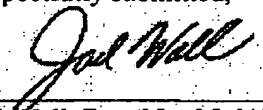(PATENT)
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IV. <u>Conclusion</u>

In view of the foregoing, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of the paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347.

Respectfully submitted,

Dated: March 4, 2004   By: _____

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